

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* ROD MANCISIDOR,  
CHARLES R. ERICKSON,  
AHMED GHEITH, and  
WILLIAM W. CHAN

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Appeal 2012-006756  
Application 12/476,285<sup>1</sup>  
Technology Center 2100

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Before HUBERT C. LORIN, JOSEPH A. FISCHETTI, and  
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Rod Mancisidor, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the rejection of claims 1–16. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

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<sup>1</sup> The Appellants identify Convergys CMG Utah as the real party in interest. App. Br. 3.

## SUMMARY OF DECISION

We AFFIRM-IN-PART and enter New Grounds of Rejection pursuant to 37 C.F.R. § 41.50(b).<sup>2</sup>

## THE INVENTION

Independent claims 1 and 6, reproduced below, are illustrative of the subject matter on appeal.

1. A system comprising:

- a) a computer readable medium and
- b) a processor;

wherein the computer readable medium has stored thereon computer executable instructions which, in combination with the processor, are operable to perform expert system processing based on one or more identified needs of a customer and to present a summary of ratings of a plurality of products to the customer based on the one or more identified needs, said expert system processing having own code response time of less than one second.

6. A system comprising:

- a) a processor configured to:

- 1) calculate a plurality of trait ratings for one or more products from a plurality of products, using at least the calculating techniques of crisp value calculation and fuzzy value calculation, using computer executable instructions stored in a computer readable medium;

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<sup>2</sup> Our decision makes reference to the Appellants' Appeal Brief ("App. Br.," filed July 13, 2011) and Reply Brief ("Reply Br.," filed Dec. 28, 2011), and the Examiner's Answer ("Ans.," mailed Nov. 1, 2011).

2) rank the one or more products from the plurality of products based at least in part on the evaluation of rules corresponding to the trait ratings;

b) a means for providing a rating summary comprising one or more rankings of the one or more products.

App. Br. 25, 26.

### THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Lai Li and Jeffrey F. Naughton, *Multiprocessor Main Memory Transaction Processing*, Proceedings of the first International Symposium on Databases in Parallel and Distributed Systems (DPDS), 177–187 (1988) (hereinafter “Li”).

I. Burhan Turksen and Ian A. Willson, *A Fuzzy Set Model for Market Share and Preference Prediction*, European Journal of Operational Research 82, 39–52 (1995) (hereinafter “Turksen”).

Brenner, et al., *CyberCarrier Service and Network Management*, Bell Labs Technical Journal, Vol. 5, Iss. 4, 44–62 (2000) (hereinafter “Brenner”).

The following rejections are before us for review:

1. Claims 6–12, 15, and 16 are rejected under 35 U.S.C. § 102(b) as being anticipated by Turksen.
2. Claims 1–5, 13, and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Turksen, Li, and Brenner.

### ISSUES

Did the Examiner err in rejecting claims 6–12, 15, and 16 under 35 U.S.C. § 102(b) as being anticipated by Turksen?

Did the Examiner err in rejecting claims 1–5, 13, and 14 under 35 U.S.C. § 103(a) as being unpatentable over Turksen, Li, and Brenner?

### FINDINGS OF FACT

We rely on the Examiner’s factual findings stated in the Answer. Additional findings of fact may appear in the Analysis below.

### ANALYSIS

*The rejection of claims 6–12, 15, and 16 under 35 U.S.C. § 102(b) as being anticipated by Turksen.*

*Claims 6–9, 15, and 16*

With respect to this group of claims, the Appellants explain that [t]he disagreement between the [United States Patent and Trademark Office (“Office”)] and the applicants regarding the rejection of claim 6 centers on a dispute regarding what is necessary to make out a prima facie case of anticipation for a claim which includes a limitation set forth in means + function form.

App. Br. 17. The Appellants then make a case for reversing the rejection on the ground that the Examiner failed to satisfy the Office’s initial burden to construe the means-plus-function clause in independent claim 6 by identifying structure in the Specification corresponding to the recited function and then showing that Turksen describes the same structure. App. Br. 17–21.

The limitation at issue is

b) a means for providing a rating summary comprising one or more rankings of the one or more products.

Claim 6.

According to the Appellants,

This is a means + function limitation as permitted by 36 U.S.C. § 112, [sixth paragraph]. Physical devices which can be used to provide a rating summary include computers providing an agent interface, as illustrated in elements 291, 292, and 293 of figure 2. Additionally, in some implementations, some or all of the function of providing a rating summary can be performed on a server as illustrated in figure 2 as element 281. Steps for providing the rating summary such as could be implemented using appropriate software are described in the application as originally filed in the passage between line 1 of page 24 and line 6 of page 25, and in lines 3-17 of page 5. Variations on this, such as providing the results of expert system processing for use in real time during an interaction between an agent and a customer are disclosed in the [S]pecification between line 10 of page 27 and line 16 of page 28.

App. Br. 8, footnote 10. The Appellants also state that

in this case, the applicants have identified structure which is inconsistent with the Office's interpretation that the means + function limitation of claim 6 is taught by the cited sections of Turksen. For example, paragraph 96 of the [S]pecification (identified explicitly as providing corresponding structure in the Previous Appeal Brief) states that "The expert system 431 performs product(s)/service(s) rating 440 using an indefinite number of rules 441."

App. Br. 19–20.

We have reviewed the cited disclosures for structure corresponding to the function recited in the limitation at issue but do not find any algorithm is disclosed. As we explain below, the absence of disclosure of an algorithm corresponding to the function recited in the limitation at issue renders claims 6–16 indefinite under 35 U.S.C. § 112, second paragraph. Accordingly, the rejection of claims 6–9, 15, and 16 is reversed pro forma as being necessarily based on speculative assumptions as to the scope of these claims. *See In re Steele*, 305 F.2d 859, 862–63 (CCPA 1962). Our decision in this

regard is based solely on the indefiniteness of the subject matter and does not reflect on the adequacy of the prior art evidence applied in support of the rejection.

*Claims 10–12*

For the same reasons set forth above, we also reverse pro forma the rejection of claims 10–12. Our decision in this regard is based solely on the indefiniteness of the subject matter and does not reflect on the adequacy of the prior art evidence applied in support of the rejection.

*The rejection of claims 1–5, 13, and 14 under 35 U.S.C. § 103(a) as being unpatentable over Turksen, Li, and Brenner.*

For the same reasons set forth above, we also reverse pro forma the rejection of claims 13 and 14. Our decision in this regard is based solely on the indefiniteness of the subject matter and does not reflect on the adequacy of the prior art evidence applied in support of the rejection.

*Claims 1–4*

The Appellants challenge the rejection of claims 1–5 on the ground that the cited prior art does not disclose the independent claim 1 limitation “where the expert system processing has own code response time of less than one second.” App. Br. 11–14.

The Examiner takes the position that Turksen discloses the processor element of the claim 1 system but

computer executable instructions which, in combination with the processor, are operable to perform expert system processing based on one or more identified needs of a customer and to present a summary of ratings of a plurality of products to the customer based on the one

or more identified needs, said expert system processing having own code response time of less than one second

(claim 1) “is not expressly taught by the primary art of [Turksen]. It is, however, expressly taught by [Li].” Ans. 8. The Examiner finds that Li discloses the following:

We measured the performance of the prototype in two configurations on the standard debit-credit benchmark described by Anon et al. [Ano85]. Briefly, that benchmark requires the system to run debit-credit transactions as fast as possible, subject to the restriction that **at least 95% of the transactions must have a response time of less than one second.**

Ans. 8 (citing Li). According to the Examiner, “[i]t would have been obvious for one of ordinary skill in the art to substitute the ‘less than one second’ processing speed requirement of [Li ] for the unspecified processing speed requirement of [Turksen] because it prevents users of the system from becoming frustrated.” Ans. 8

We find that the Examiner has presented a prima facie case of obviousness for the claimed subject matter over the Turksen and Li by a preponderance of the evidence.

The Appellants argue that “no explanation was provided for how Li could enable one of ordinary skill in the art to modify Turksen so as to include expert system processing having own code response time of less than one second.” App. Br. 12. We disagree with that characterization. The Examiner reasonably broadly construed the claim to cover a system comprising a processor capable of performing expert system processing to effect an “expert system processing having own code response time of less than one second” (claim 1). The Examiner finds Turksen to disclose a processor, a finding of fact that is not in dispute, but also finds Turksen

deficient in not “expressly” teaching (Ans. 8) a processor capable of performing expert system processing to effect an “expert system processing having own code response time of less than one second” (claim 1). The Examiner relies on Li for such a processor. The Examiner provides an apparent reasoning (i.e., less frustration) with logical underpinning for substituting Li’s processor for that generally disclosed in Turksen. *See* Ans. 8. There is insufficient evidence on the record before us that what is claimed is more than a mere substitution of a speedier processor. *Cf. KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007) (“when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.”) (citation omitted).

The Appellants argue that “[t]he Office presented no evidence or argument that the increase in computer speed between 1995 and 2000 was enough to render claim 1 obvious over Turksen” (App. Br. 13) and “it made no showing that the expert system processing of Turksen is fast enough that the change in processing power between 1995 and 2000 would render the sub-second response time of claim 1 obvious” (App. Br. 13–14). The argument is unpersuasive as to error in the rejection. The Specification provides no details about what is required of a processor to effect an “expert system processing having own code response time of less than one second” (claim 1). “Response time” is mentioned only once, at paragraph 125, without further discussion. In discussing agents able to access the expert system of the invention, the Specification mentions a laptop computer, a computer, a handheld computer and “any portable device that is operable to

perform electronic interaction with the expert system” (Spec. para. 85), suggesting the use of a conventional processor. The evidence suggests that no particular processor is necessary. When read in light of these disclosures, one of ordinary skill in the art would understand the claimed system to reasonably broadly cover any processor that is capable of performing expert system processing to effect an “expert system processing having own code response time of less than one second” (claim 1). In that regard, there is no dispute that Li’s processor has that capability. Given insufficient evidence on the record before us that what is claimed is more than a mere substitution of a speedier processor, we find that the Appellants’ arguments as to the insufficiency of the Examiner’s position unpersuasive.

*Claim 5*

Claims 5 further limits the customer profiles stored in profile databases per claim 3 so that they “comprise[ ] information regarding products that the customer currently has at their disposal.”

The Appellants argued, in part, that “the customer profiles of the applicant’s invention are profiles containing information about customer. Attribute values of a product [that Turksen discloses] cannot be reasonably read to include information regarding a customer.” App. Br. 16. In effect, the Appellants are arguing that the claimed subject matter differs from that of Turksen because the information is different.

A difference over the prior art in the type of information is a difference in descriptive material. Patentable weight need not be given to descriptive material absent a new and unobvious functional relationship

between the descriptive material and the substrate. *See In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004). *See also In re Lowry*, 32 F.3d 1579, 1582–83 (Fed. Cir. 1994). The Appellants have not come forward with evidence sufficient to show that the structure of the claimed system is functionally affected by:

one or more customer profiles compris[ing] information regarding products that the customer currently has at their disposal.

Claim 5. Absent such evidence, it is reasonable to conclude that the type of information (i.e., “regarding products that the customer currently has at their disposal”) to which the claim is directed is at best descriptive and not functionally related to any structure of the claimed system, and as such falls under the category of patentably-inconsequential subject matter. *See Ex parte Curry*, 84 USPQ2d 1272, 1275 (BPAI 2005) (informative). “Non-functional descriptive material cannot render nonobvious an invention that would have otherwise been obvious.” *Curry*, 84 USPQ2d at 1274 (citing *Ngai*, 367 F.3d at 1339). *Cf. In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (“when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability”). *See also In re Xiao*, 462 Fed. Appx. 947, 950–52 (Fed. Cir. 2011) (non-precedential):

[T]he Board did not create a new “mental distinctions” rule in denying patentable weight . . . . On the contrary, the Board simply expressed the above-described functional relationship standard in an alternative formulation—consistent with our precedents—when it concluded that any given position label’s function . . . is a distinction “discernable only to the human mind.” . . . ; *see In re Lowry*, 32 F.3d 1579, 1583 (Fed. Cir.

1994) (describing printed matter as “useful and intelligible only to the human mind”) (quoting *In re Bernhart*, . . . 417 F.2d 1395, 1399 (CCPA 1969)).

*Xiao*, 462 Fed. Appx. at 951–952. “Thus non-functional descriptive material, being useful and intelligible only to the human mind, is given no patentable weight.” *Ex parte Graf*, Appeal 2012-003941, slip op. at 7 (PTAB July 23, 2013) (non-precedential)(citation omitted), affirmed, *In re Graf*, (PTAB October 30, 2013) (non-precedential), affirmed, *In re Graf*, 585 Fed. Appx. 1012 (Fed. Cir. 2014) “The rationale behind this line of cases is preventing the indefinite patenting of known products by the simple inclusion of novel, yet functionally unrelated limitations.” *King Pharms., Inc. v. Eon Labs, Inc.*, 616 F.3d 1267, 1279 (Fed. Cir. 2010) (citing *Ngai*, 367 F.3d at 1339).

For the foregoing reason, we are unpersuaded as to error in the rejection of claim 5 by the Appellants’ argument the claimed subject matter is patentable because Turksen discloses attribute values of a product.

#### NEW GROUNDS OF REJECTION

*Claims 6–16 are rejected under 35 U.S.C. § 112(b) as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventors regard as the invention.*

A claim limitation that includes the term “means” is presumed to be intended to invoke means-plus-function treatment, i.e., treatment under 35 U.S.C. § 112, sixth paragraph. *Rodime PLC v. Seagate Tech., Inc.*, 174 F.3d 1294, 1302 (Fed. Cir. 1999) (“presumed an applicant advisedly used the word “means” to invoke the statutory mandates for means-plus-function clauses.”) (citation omitted). The Appellants do not dispute that

such treatment applies to the claims at issue. When the presumption is not been rebutted, as here, means-plus-function claim language must be construed in accordance with 35 U.S.C. § 112, sixth paragraph, by “look[ing] to the specification and interpret[ing] that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure.” *In re Donaldson Co.*, 16 F.3d 1189, 1193 (Fed. Cir. 1994)(en banc).

[There is no dispute that this limitation is written in means-plus-function form and falls under 35 U.S.C. § 112, ¶ 6, (Section 112, paragraph 6 provides: “An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure ... in support thereof, and such claim shall be construed to cover the corresponding structure ... described in the specification and equivalents thereof.” 35 U.S.C. § 112, ¶ 6 (2000).), the first step in the construction of a means-plus-function claim element is to identify the particular claimed function. *Micro Chem., Inc. v. Great Plains Chem. Co.*, 194 F.3d 1250, 1258 (Fed. Cir. 1999). The second step in the analysis is to look to the specification and identify the corresponding structure for that function. *Id.* Under this second step, “structure disclosed in the specification is ‘corresponding’ structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim.” *B. Braun Med., Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424 (Fed. Cir. 1997).

*Medical Instrumentation and Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1210 (Fed. Cir. 2003).

The means-plus-function limitation at issue is

b) a means for providing a rating summary comprising one or more rankings of the one or more products.

Claim 6. There is no dispute that the function set forth in said means-plus-function clause in claim 6 broadly covers implementation on a computer.

The particular claimed function is: “providing a rating summary comprising one or more rankings of the one or more products.”

For computer-implemented means-plus-function claims where the disclosed structure is a computer programmed to implement an algorithm, “the disclosed structure is not the general purpose computer, but rather the special purpose computer programmed to perform the disclosed algorithm.” *WMS Gaming, Inc. v. Int’l Game Tech.*, 184 F.3d 1339, 1349 (Fed. Cir. 1999). Thus the patent must disclose, at least to the satisfaction of one of ordinary skill in the art, enough of an algorithm to provide the necessary structure under § 112, ¶ 6. This court permits a patentee to express that algorithm in any understandable terms including as a mathematical formula, in prose, *see In re Freeman*, 573 F.2d 1237, 1245–46 (CCPA 1978), or as a flow chart, or in any other manner that provides sufficient structure.

*Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 1340 (Fed. Cir. 2008).

We have reviewed the Specification for disclosure of the structure corresponding to this function. We do not see there any mention of an algorithm corresponding to “providing a rating summary comprising one or more rankings of the one or more products” (claim 6). We see there discussion of instructions for the processor element of the claim 6 system, but not of the other “means” element of the claim 6 system.

The Appellants cite elements 281, 291, 292, and 293 of figure 2. App. Br. 8, footnote 10. But they are simply boxes that include the words “Server,” “Laptop Computer,” “Computer,” and “Handheld Computer”, respectively.

We do not see any mention of an algorithm corresponding to “providing a rating summary comprising one or more rankings of the one or more products” (claim 6) in the other passages the Appellants cite (App. Br. 8, footnote 10: “in the application as originally filed in the passage between

line 1 of page 24 and line 6 of page 25, and in lines 3–17 of page 5” and “between line 10 of page 27 and line 16 of page 28”).

Finally the Appellants state the following: “For example, paragraph 96 of the specification (identified explicitly as providing corresponding structure in the Previous Appeal Brief) states that “[t]he expert system 431 performs product(s)/service(s) rating 440 using an indefinite number of rules 441.” App. Br. 20. In our view, one of ordinary skill in the art would not interpret “an indefinite number of rules” as imparting an algorithm.

We are cognizant that “[a]ll one needs to do . . . is to recite some structure corresponding to the means in the specification . . . so that one can readily ascertain what the claim means and comply with the particularity requirement of [paragraph] 2.” *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1382 (Fed. Cir. 1999). But “[s]imply disclosing software, however, ‘without providing some detail about the means to accomplish the function[,] is not enough.’” *Noah Syss., Inc. v. Intuit, Inc.*, 675 F.3d 1302, 1312 (Fed. Cir. 2012) (quoting *Finisar Corp.*, 523 F.3d at 1340–41 (Fed. Cir. 2008)). “While it is true that the patentee need not disclose details of structures well known in the art, . . . the specification must nonetheless disclose some structure.” *Default Proof Credit Card Sys., Inc. v. Home Depot U.S.A., Inc.*, 412 F.3d 1291, 1302 (Fed. Cir. 2005). Here the Specification disclosure to which the Appellants cite provides no details, examples, or explanation of how to perform the recited function at issue. At best, the disclosure suggests devising software to perform the function. However, our review court held:

[a] patentee cannot avoid providing specificity as to structure simply because someone

of ordinary skill in the art would be able to devise a means to perform the claimed function. To allow that form of claiming under section 112, paragraph 6, would allow the patentee to claim all possible means of achieving a function.

[*Blackboard, Inc. v. Desire2Learn, Inc.*, 574 F.3d 1371, 1385 (Fed. Cir. 2009)]. “Section 112, paragraph 6, is intended to prevent such pure functional claiming.” *Id.* (citing *Aristocrat Techs. Australia Pty Ltd. v. Int’l Game Tech.*, 521 F.3d 1328, 1333 (Fed. Cir. 2008).

*Function Media, L.L.C. v. Google, Inc.*, 708 F.3d 1310, 1319 (Fed. Cir. 2013).

For the foregoing reasons, claims 6–16 are rejected under 35 U.S.C. § 112(b) as being indefinite.

Claims 1–5 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

We select claim 1 as representative of the claims being rejected.

The Supreme Court has long held that laws of nature, abstract ideas, and natural phenomena are excluded from patent protection. *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S.Ct. 2347, 2354 (2014) (citing *Assoc. for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S.Ct. 2107, 2116 (2013) (internal quotation marks and brackets omitted)). *See also Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293 (2012); *Diamond v. Diehr*, 450 U.S. 175, 185 (1981). Yet although a law of nature or an abstract idea, by itself, is not patentable, a practical application of the law of nature or abstract idea may be deserving of patent protection. *See Mayo*, 132 S. Ct. at 1293–94.

In *Alice*, the Supreme Court reiterated the framework, set forth previously in *Mayo*, “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of [these] concepts.” *Alice*, 134 S. Ct. at 2355 (citation omitted). The first step in this analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id* (citation omitted). If so, in the second step, the elements of the claims “individually and ‘as an ordered combination’” are considered to determine whether there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 132 S. Ct. at 1297). Stated differently, the second step is a “search for an ‘inventive concept’ – *i.e.*, an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Id.* (brackets in original) (quoting *Mayo*, 132 S. Ct. at 1294).

Claim 1 is directed to a “system” comprising two elements: a computer readable medium and a processor. The computer readable medium has stored thereon computer executable instructions. According to claim 1, the instructions and the processor, in combination, are operable to perform “expert system processing” based on certain needs and to present certain information based on those needs. Claim 1 also defines the “expert system processing [as] having own code response time of less than one second.”

The Specification states that “[t]he present invention relates generally to expert systems.” Spec. ¶ 2.

Claim 1 is not unlike the claims that the court encountered in *SmartGene, Inc. v. Advanced Biological Labs., SA*, 555 Fed. Appx. 950 (Fed. Cir. 2014) (Unpublished). Like here, *SmartGene* involved claims to an expert system<sup>3</sup>. The court found “[representative] Claim 1 does no more than call on a ‘computing device,’ with basic functionality for comparing stored and input data and rules, to do what doctors do routinely.” *Id.* at 954.

The claim does not purport to identify new computer hardware: it assumes the availability of physical components for input, memory, look-up, comparison, and output. Nor does it purport to identify any steps beyond those which doctors routinely and consciously perform. *Id.* at 955. The court found the claims were directed to a mental process and as such excluded as patent-ineligible subject matter. “Whatever the boundaries of the ‘abstract ideas’ category, the claim at issue here involves a mental process excluded from section 101: the mental steps of comparing new and stored information and using rules to identify medical options.” *Id.*

Given the similarity between instant claim 1 and the claims in *SmartGene* in defining an expert system, we take the same view; that is,

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<sup>3</sup> Although the phrase “expert system” does not occur in *SmartGene*, the claimed method at issue involved a “knowledge base” and generating a “ranked listing” via a computing device; in effect, an expert system. According to *Webster’s New World Dictionary of Computer Terms* (Eighth Edition, 2000, page 199), an “expert system” is “[a] program that contains much knowledge used by an expert in a specific field and that assists non-experts as they try to solve problems. Expert systems contain a knowledge base expressed in a series of IF/THEN rules and an engine capable of drawing inferences from this knowledge base. The system prompts you to supply information needed to access the situation and come to a conclusion. Most expert systems express conclusions with a confidence factor, ranging from speculation to educated guess to a firm conclusion.” Emphasis added.

claim 1 involves the mental steps of identifying a customer's needs and presenting a summary of ratings of a plurality of products to the customer based on said identified needs.

Because we find that claim 1, as reasonably broadly construed, recites mental steps, claim 1 is directed to a patent-ineligible subject matter.

Turning to the second step outlined in *Alice*, we next consider whether there is an inventive concept, defined by an element or combination of elements in claim 1, which is significantly more than mental steps. We conclude here that there is no such inventive concept.

Similar to *SmartGene*, we find that instant claim 1 does not “purport to identify new computer hardware: it assumes the availability of physical components for input, memory, look-up, comparison, and output. Nor does it purport to identify any steps beyond those” (*SmartGene*, 555 Fed.Appx at 955) which salespersons routinely and consciously perform.

We note that claim 1 calls for an “expert system processing having own code response time of less than one second” (claim 1). But, as we discussed earlier in this decision, the Specification provides no details about what is required of a processor to effect an “expert system processing having own code response time of less than one second” (claim 1). “Response time” is mentioned only once, at paragraph 125, without further discussion. In discussing agents able to access the expert system of the invention, the Specification mentions a laptop computer, a computer, a handheld computer and “any portable device that is operable to perform electronic interaction with the expert system” (Spec. ¶ 85) suggesting the use of a conventional processor. The evidence on record suggests that no particular processor is

necessary. When read in light of these disclosures, one of ordinary skill in the art would understand the claimed system to reasonably broadly cover any processor that is capable of performing expert system processing to effect an “expert system processing having own code response time of less than one second” (claim 1). In that regard, the record includes evidence (e.g., Li) that processors having said capability were known in the art at the time of the invention.

For the foregoing reasons, we find that claim 1 does not include additional inventive features such that the claim scope does not solely capture the abstract idea.

Therefore, claims 1–5 are rejected under 35 U.S.C. § 101.

### CONCLUSIONS

The rejection of claims 6–12, 15, and 16 under 35 U.S.C. § 102(b) as being anticipated by Turksen is reversed pro forma.

The rejection of claims 13, and 14 under 35 U.S.C. § 103(a) as being unpatentable over Turksen, Li, and Brenner is reversed pro forma.

The rejection of claims 1–5 under 35 U.S.C. § 103(a) as being unpatentable over Turksen, Li, and Brenner is affirmed.

Claims 1–5 are newly rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 6–16 are newly rejected under 35 U.S.C. § 112(b) as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventors regard as the invention.

## DECISION

The decision of the Examiner to reject claims 1–16 is affirmed-in-part.

Claims 1–5 and 6–16 are newly rejected under 35 U.S.C. § 101 and 35 U.S.C. § 112(b), respectively.

## NEW GROUND

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” 37 C.F.R. § 41.50(b) also provides that the Appellants, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION:**

must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the Examiner . . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record . . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)

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